



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,156	10/04/2005	Tasuku Amemiya	Q85728	9035
23373	7590	12/04/2009	EXAMINER	
SUGHRUE MION, PLLC			KIM, KEVIN Y	
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037			3714	
			NOTIFICATION DATE	DELIVERY MODE
			12/04/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary	Application No.	Applicant(s)	
	10/521,156	AMEMIYA ET AL.	
	Examiner	Art Unit	
	KEVIN Y. KIM	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 September 2009.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-12 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (US 6,594,640 B1) in view of Martinez et al (US 6,119,229), Atalla (US 4,268,715), Durst, JR et al (US 2001/0032252 A1), and Saliba et al (US 2001/0037315 A1).

3. In re claim 8, Postrel discloses a point transfer system including first and second databases (figure 4, 54 and 52), each storing point information, comprising:

point information updating means for updating the point information stored in the first database (column 6, lines 47-50). This limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph. The point offering means of Postrel are considered an equivalent to applicant's means (page 18, lines 19-25) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification.

See MPEP 2183.

point inquiry request receiving means for receiving a point inquiry request (column 6, lines 7-11 and column 11, line 66 to column 12, line 1). This limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph.

In order for the account information to be obtained, the user logs in and requests said information through the web browser and by entering the appropriate information. The point inquiry means of Postrel are considered an equivalent to applicant's means (page 19, lines 2-7) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

point transferring request receiving means for receiving a point transfer request (column 6, lines 20-37). This limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph. The point transferring means of Postrel are considered an equivalent to applicant's means (page 15, line 18 to page 16, line 8) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

point information returning means for returning the point information stored in the first database when the point inquiry request is received by the point inquiry request receiving means (column 6, lines 25-30). This limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph. The point information returning means of Postrel are considered an equivalent to applicant's means (page 15, line 18 to page 16, line 8) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

However, Postrel does not disclose:

secret identification information updating means for updating secret identification information stored in the first database in association with the point information when the point information stored in the first database is updated by the point information updating means;

secret identification information returning means;

the point transfer request receiving means including secret identification information;

first point transferring means for updating the point information stored in the first database to decrease a point balance and returning point transfer allowance data when the secret identification information included in the point transfer request received by the point transfer request receiving means matches the secret identification information stored in the first database; and

second point transferring means for updating the point information stored in the second database to increase a point balance when the point transfer allowance data is returned by the first point transferring means. All of the previous limitations meet the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph.

Atalla teaches:

secret identification information updating means (column 3, lines 45-48). The means of Atalla is considered an equivalent to applicant's means (page 21, line 24 to page 22, line 11), as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

a transaction that occurs only when the secret information (the ID) from one file matches the secret information from the other (column 3, line 54 to column 4, line 7). The verification method of Atalla is considered an equivalent to applicant's means (page 21, line 24 to page 22, line 11) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

providing the secret identification information when requested (column 3, line 54 to column 4, line 7), thus returning the information.

While Atalla and Postrel are silent on returning secret identification information upon receiving a point inquiry request, it is a well known feature in the art to allow for the retrieval of secret identification information upon request by a user. There will be cases in which the user forgets his or her password to an account, and thus, may request for the password to be emailed or otherwise sent to the user as a reminder, as can be seen in Durst (paragraph [0134]). The request being a point inquiry request is merely an obvious design choice, as one skilled in the art could choose to send any sort of information upon the request for secret information, or alternatively, to send secret information in the point inquiry request, without undue experimentation and with predictable results. Finally, while Durst does not return both point and secret identification information, Atalla has already been discussed regarding secret identification information. One skilled in the art would have found it obvious to return both information types, as it is an obvious design choice that yields the predictable result of allowing a player access to the information related to their account, whether it

be their secret information or point information.

While Atalla and Postrel do not explicitly disclose a comparison means for comparing information with data in a database, this is an obvious design choice. Postrel is directed towards allowing players to trade in points accumulated in frequent use programs, such as in a credit card or similar card. Such cards often require the use of a PIN to access the account (for example, when a user inserts the card at an ATM). Inherently, this number would be compared with the database owned by the company, to ensure that the user's password or PIN matches the database records. Without such a safeguard, anybody would be able to use anybody's account, leading to mass fraudulent activity.

Finally, the above are silent on secret identification information being updated when point information is updated. Saliba teaches providing a user the ability to update account information, personal information, credit information, etc. (paragraph [0092]). Thus, the user is able to update secret identification information at the same time as updating point information.

It would have been obvious to one skilled in the art at the time the invention was made to combine the first and second point transferring means with the methods of Atalla and Durst for the predictable improvement of improving security of data transmissions between stations by making it unnecessary to transmit user-identification information between the stations, while making it possible for users to be reminded of their secret information. It would also have been obvious to allow users to update

secret identification information when point information is updated in order to allow users to keep their personal information up to date.

4. In re claim 9, Atalla teaches the secret identification information updating the information based on a random number (column 3, line 45 to column 4, line 7).

5. In re claims 10 and 11, please see rejection for claim 8.

6. In re claim 12, Postrel discloses a network game system, comprising:
a first game (column 11, lines 41-44) server (figure 4, 20);
a first database (figure 4, 54) connected to the first server for storing point information in association with user identifying information related to the user in the first server (column 7, lines 14-19 and figure 5, 54, “user accounts,” “user preferences,” etc.). As disclosed, database 54 stores the user’s reward exchange account, and transfer of points into said account is possible (column 7, lines 21-23).

a second game (column 11, lines 41-44) server (figure 4, 10, 12, or 14); and
a second database connected to the second server (figure 4, 52 and column 6, lines 17-20) for storing point information in association with user identifying information related to the user in the second service (column 5, lines 39-43); wherein

the first game server includes
point information updating means for updating the point information stored in the first database (column 6, lines 47-50). This limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph. The point information updating means of Postrel are considered an equivalent to applicant’s means (page 18,

lines 19-25) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

point information returning means for returning the point information stored in the first database when the point inquiry request is received by the point inquiry request receiving means (column 6, lines 25-30). This limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph. The point information returning means of Postrel are considered an equivalent to applicant's means (page 15, line 18 to page 16, line 8) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

point inquiry request receiving means for receiving a point inquiry request (column 6, lines 7-11 and column 11, line 66 to column 12, line 1). This limitation meets the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph. In order for the account information to be obtained, the user logs in and requests said information through the web browser and by entering the appropriate information. The point inquiry means of Postrel are considered an equivalent to applicant's means (page 19, lines 2-7) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

However, Postrel does not disclose:

secret identification information updating means for updating secret identification

information stored in the first database in association with the point information when the point information stored in the first database is updated by the point information updating means;

secret identification information returning means;

the point transfer request receiving means including secret identification information;

first point transferring means for updating the point information stored in the first database to decrease a point balance and returning point transfer allowance data when the secret identification information included in the point transfer request received by the point transfer request receiving means matches the secret identification information stored in the first database; and

the second game server including

second point transferring means for updating the point information stored in the second database to increase a point balance when the point transfer allowance data is returned by the first point transferring means. All of the previous limitations meet the three-prong test per MPEP 2181 and thereby invokes 35 U.S.C. 112 6th paragraph.

Atalla teaches:

secret identification information updating means (column 3, lines 45-48). The means of Atalla is considered an equivalent to applicant's means (page 21, line 24 to page 22, line 11), as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

a transaction that occurs only when the secret information (the ID) from one file matches the secret information from the other (column 3, line 54 to column 4, line 7). The verification method of Atalla is considered an equivalent to applicant's means (page 21, line 24 to page 22, line 11) as it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in applicant's specification. See MPEP 2183.

providing the secret identification information when requested (column 3, line 54 to column 4, line 7), thus returning the information.

However, Postrel is silent on said second server providing the second service directly to a user, as it communicates with the central server. Martinez teaches a system that provides services to users via a server (figure 1, 20). Said server may comprise a plurality of servers (column 3, lines 8-16). Thus, it would have been obvious to one skilled in the art at the time the invention was made to utilize multiple servers to provide services directly to users as taught by Martinez, as it is a well known design choice to provide multiple servers, due to the fact that a single server has a limited capacity for bandwidth, and eventually will be filled to capacity, which is easily rectified with the addition of extra servers.

While Atalla and Postrel are silent on returning secret identification information upon receiving a point inquiry request, it is a well known feature in the art to allow for the retrieval of secret identification information upon request by a user. There will be cases in which the user forgets his or her password to an account, and thus, may request for the password to be emailed or otherwise sent to the user as a reminder, as

can be seen in Durst (paragraph [0134]). The request being a point inquiry request is merely an obvious design choice, as one skilled in the art could choose to send any sort of information upon the request for secret information, or alternatively, to send secret information in the point inquiry request, without undue experimentation and with predictable results. Finally, while Durst does not return both point and secret identification information, Atalla has already been discussed regarding secret identification information. One skilled in the art would have found it obvious to return both information types, as it is an obvious design choice that yields the predictable result of allowing a player access to the information related to their account, whether it be their secret information or point information.

Finally, the above are silent on secret identification information being updated when point information is updated. Saliba teaches providing a user the ability to update account information, personal information, credit information, etc. (paragraph [0092]). Thus, the user is able to update secret identification information at the same time as updating point information.

While Atalla and Postrel do not explicitly disclose a comparison means for comparing information with data in a database, this is an obvious design choice. Postrel is directed towards allowing players to trade in points accumulated in frequent use programs, such as in a credit card or similar card. Such cards often require the use of a PIN to access the account (for example, when a user inserts the card at an ATM). Inherently, this number would be compared with the database owned by the company, to ensure that the user's password or PIN matches the database records. Without such

a safeguard, anybody would be able to use anybody's account, leading to mass fraudulent activity. It would have been obvious to one skilled in the art at the time the invention was made to combine the first and second point transferring means with the method of Atalla and Durst for the predictable improvement of improving security of data transmissions between stations by making it unnecessary to transmit user-identification information between the stations, while making it possible for users to be reminded of their secret information. It would also have been obvious to allow users to update secret identification information when point information is updated in order to allow users to keep their personal information up to date.

Response to Arguments

7. Applicant's arguments filed 9/15/2009 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., points may not be transferred, and point information cannot be updated again until a further point inquiry request is made) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Specifically, the claim only mentions secret identification information in the point transfer request matching the information stored in the database. As Saliba has discussed, information may be updated whenever desired. Because of this, one skilled in the art has the capability and

knowledge to implement this update at any desired time, interval, or other schedule. Automatically performing the update at a certain time would be obvious to one skilled in the art at the time of the invention in order to ensure that security is maintained and ensured each and every time access is required.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN Y. KIM whose telephone number is (571)270-3215. The examiner can normally be reached on Monday-Thursday, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/K. Y. K./
Examiner, Art Unit 3714